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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,718	12/28/2001	Grigor Markarian	CITI0243	4085

7590

12/22/2004

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EXAMINER
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BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/028,718

**Applicant(s)**

MARKARIAN ET AL.

**Examiner**

Igor Borissov

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-18 is/are rejected.
- 7) ☒ Claim(s) 14-17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) _____<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

Amendment received on 10/12/2004 is acknowledged and entered. **Claim 13** has been canceled. **Claims 12 and 18** have been amended. **Claims 1-12 and 14-18** are currently pending in the application.

### ***Claim Objections***

**Claims 14-17** are objected to because of the following informalities: **claims 14-17** appear to have typographical error "*The ... system*", because **claims 14-17** depend on a method claim while reciting a system. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-12 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eerola (US 6,678,518) in view of Tomkins (US 2001/0056401).**

Eerola teaches a method and system for dynamically converting data between a mobile station in a wireless communication network and an origin server in a wide area network, comprising:

**Claims 1, 12 and 18**, sending from a mobile station a Wireless Markup Language (WML) encoded URL request for a resource (C. 4, L. 14; C. 5, L. 15-17); receiving said request at a gateway server and re-formatting said request into HTML format (C. 4, L. 15; C. 5, L. 18-26); communicating said re-formatted request to a particular resource information on the World Wide Web and receiving the requested

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resource information at said gateway (C. 5, L. 18-26); parsing said received resource information and re-formatting the processed information into WML encoded message to transmit it back to said mobile station (C. 5, L. 36-50).

Eerola does not specifically teach: *sending a purchase request to a merchant website; sending a purchase request response, including a payment authorization request, from the merchant website to a payment authorization system; and transmitting said purchase request response to the mobile device.*

Tomkins teaches a method and system for providing financial services over the Internet, including: sending a purchase request from a customer mobile terminal (cell phone) to a merchant website; transmitting a payment authorization request from the merchant website to a bank server which authorizes or denies the transaction; notifying the customer that the transaction has been approved or denied [0065]; [0028]; wherein the protocol conversion aspect converts content developed in HTML into Wireless Markup Language (WML) [0032].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Eerola to include said cell phone purchase request and authorization functionality, as disclosed in Tomkins, because it would advantageously allow customers to conduct shopping over the Internet at any suitable location and at any time convenient for the customer.

Furthermore, Eerola teaches:

**Claims 2 and 14**, said method and system, wherein said first language is wireless language (C. 4, L. 14; C. 5, L. 15-17).

**Claims 3 and 15**, said method and system, wherein said first language is Wireless Markup Language (WML) (C. 4, L. 14; C. 5, L. 15-17).

**Claims 4 and 16**, said method and system, wherein said second language is web-based language (C. 4, L. 15; C. 5, L. 18-26);

**Claims 5 and 17**, said method and system, wherein said second language is HTML language (C. 4, L. 15; C. 5, L. 18-26);

**Claim 6.** Said system, including a parsing engine, a communication module, a translation/formatting module, and an administrator module (C. 4, L. 13-34).

**Claim 7.** Tomkins teaches said system, including a customer account database [0031]. The motivation to combine Eerola and Tomkins would be to advantageously allow customers to conduct shopping over the Internet at any suitable location and at any time convenient for the customer.

**Claim 8.** Tomkins teaches said system, including a notification system for notifying a customer through the mobile device, and a payment authorization system for responding to the authorization request [0065]; [0028]. The motivation to combine Eerola and Tomkins would be to advantageously allow customers to conduct shopping over the Internet at any suitable location and at any time convenient for the customer.

**Claim 9.** Tomkins teaches said system, wherein the notification system communicates with the mobile device in a third (Compact HTML) language [0032]. The motivation to combine Eerola and Tomkins would be to advantageously allow customers to conduct shopping over the Internet at any suitable location and at any time convenient for the customer.

**Claim 11.** Tomkins teaches said system, including a customer information repository including a customer shipping address, a list of payment vehicles and a customer ID [0070]. The motivation to combine Eerola and Tomkins would be to advantageously allow customers to conduct shopping over the Internet at any suitable location and at any time convenient for the customer.

**Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eerola in view of Tomkins and further in view of Wells et al. (US 6,078,820) (Wells).**

**Claim 10.** Eerola in view of Tomkins teach all the limitations of claim 10, except that said third language is short message services (SMS).

Wells teaches a system for real-time SMS application messaging, which includes a SMS-linked server (C. 3, L. 8-9).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Eerola and Tomkins to include a SMS functionality, as

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disclosed in Wells, because it would advantageously allow SMS system users to conduct e-commerce in any convenient location and any suitable time without incurring high cost for wireless connection.

### ***Response to Arguments***

Applicant's arguments filed 10/12/2004 have been fully considered but they are not persuasive.

In response to the applicant's argument that Eerola does not teach *a payment authorization system and a notification system*, it is noted that Tomkins was applied for this feature. Specifically, Tomkins teaches: transmitting a payment authorization request from the merchant website to a bank server which authorizes or denies the transaction; notifying the customer that the transaction has been approved or denied (See: [0065] and a discussion above).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

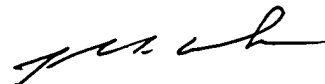
or faxed to:

**(703) 872-9306** [Official communications; including After Final  
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

IB

12/14/2004



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